

Appl. No. 09/827,192

Amdt. Dated February 9, 2004

Reply of Office action of November 13, 2003

Remarks

Claims 1-35 are pending in the instant application. Claims 19 – 35 were withdrawn in the amendment dated October 6, 2003 and have been canceled. In addition, claims 7 and 16 have been canceled. Claims 1 and 10 have been amended to recite that activating the retractive material provides a waistband-to-hip circumference ratio of about 95 percent or less at a 70 gram loading and a waistband-to-hip circumference ratio of about 100 percent at a 2000 gram loading. Support for these amendments appears throughout the specification and particularly at page 3, line 35 – page 4, line 1, and at page 4, lines 30 – 35. No new matter is added by these amendments. Accordingly, claims 1 – 6, 8 – 15, and 17 and 18 form the subject matter of the response. Based on the remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

Rejections Under 35 U.S.C. § 103(a)**The combination of Elsberg and Jessup Fail to teach or suggest all of the claim limitations.**

In the Office Action mailed November 13, 2003, the Examiner rejects claims 1, 3, 7-10, 12, and 14-18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,022,432 issued February 8, 2000 to Elsberg et al. (hereinafter "Elsberg") in view of U.S. Patent No. 5,669,996 issued September 23, 1997 to Jessup (hereinafter "Jessup"). Claims 7 and 16 have been canceled. As to the remaining claims, this rejection is respectfully **traversed** to the extent that it applies to the presently presented claims.

Elsberg is directed to methods of making prefastened disposable absorbent articles which have side bonds and adjustable fastening systems. Jessup is directed to methods of joining an elastic material to a continuously moving, partially elastic substrate.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

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Independent claims 1 and 10 of the present invention, as amended, are directed to a process for making a prefastened and refastenable pant that includes, *inter alia*, the step of activating at least a portion of retractive material causing retraction of the retractive material, where "activating the retractive material provides a waistband-to-hip circumference ratio of about 95 percent or less at a 70 gram loading and a waistband-to-hip circumference ratio of about 100 percent at a 2000 gram loading (emphasis added)."

Elsberg and Jessup, alone or in combination fail to teach or suggest the above referenced element of the present invention. That is, Elsberg and Jessup fail to teach or suggest the element of providing a "waistband-to-hip circumference ratio of about 95 percent or less at a 70 gram loading and a waistband-to-hip circumference ratio of about 100 percent at a 2000 gram loading." As set forth on page 4, lines 4 – 6 of the specification, "[t]he smaller circumference at the waistband can hold the pant up on the body when worn, especially when the pant is weighted down with water, urine, BM or other substances encountered during use." At the same time, the absorbent article of the present invention is configured to provide, "[a]t significantly higher forces, for example about 2000 grams, [a] WHCR [that] can be 100 percent so that the product is easy to raise up over the hips." Page 4, lines 34 -35 of the Specification.

Applicants note that with respect to the waistband-to-hip circumference ratio of the present invention, the Examiner, on Page 7 of the Office Action dated November 13, 2003, believes that "one skilled in the art of manufacturing an undergarment would have readily appreciated that the waistband would have been contracted as claimed to provide a better fit to the wearer," and that "[o]ne skilled in the art...would have provided the proper amount of elastic material...in order to facilitate the proper contraction in the waistband to provide a specified waistband to hip ratio." Further, on Page 8 of the Office Action dated November 13, 2003, the Examiner relies on "routine experimentation" to assert that "one skilled in the art...would have been driven...to determine the specified ratio." To the extent that these positions apply to the presently presented claims, Applicants disagree.

Applicants submit that the Examiner is improperly relying on hindsight based on the teachings of the present invention in order to arrive at these positions. This is particularly true in this instance where the Examiner has not pointed to any support for the above assertions. Instead, it appears that the Examiner is suggesting that it would always be obvious for one of ordinary skill in the art to try varying different parameters of a product in order to optimize the

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effectiveness of the product, even if there is no reference in the record recognizing that varying a particular parameter provided a particular result. As set forth in MPEP § 2145(X)(B), such an "obvious to try" position is improper.

Further, Applicants point out that the Examiner is erroneously applying the standard of "routine experimentation" in the instant application. As set forth in MPEP § 2144.05(II)(B), "[a] particular parameter must first be recognized as a result-effective variable...before the determination if the optimum or workable ranges of said variable might be characterized as routine experimentation." Applicants submit that the Examiner has not established where the prior art recognized that the waistband-to-hip circumference ratio is a result-effective variable.

As set forth above, the Applicants urge that the Examiner's positions are largely grounded in unestablished prior art. Should the Examiner persist in relying on facts within his personal knowledge, Applicants hereby call for the Examiner to support any such facts by way of providing documentary evidence in accordance with MPEP § 2144.03.

Accordingly, for at least the reasons set forth above, Applicants respectfully assert that the Examiner has not set forth a *prima facie* case of obviousness and therefore claims 1 and 10, as amended, are patentable over Elsberg in view of Jessup. Moreover, claims 2 – 6, 8 – 15, 17 and 18 all eventually depend from claims 1 or 10; therefore, these claims are also accordingly patentable over Elsberg in view of Jessup.

The combination of Elsberg and Jessup further in view of Roland or Thorson fail to teach or suggest all of the claim limitations.

In the Office Action mailed November 13, 2003, the Examiner rejects claims 2, 4 – 5, and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Elsberg in view of Jessup and further in view of U.S. Patent No. 4,665,306 issued May 12, 1987 to Roland et al. (hereinafter "Roland") or U.S. Patent No. 4,680,450 issued July 14, 1987 to Thorson et al. (hereinafter "Thorson"). This rejection is respectfully **traversed** to the extent it applies to the presently presented claims.

Claims 2 and 11 depend from independent claims 1 and 10 and are further recite that the step of activating the retractive material includes applying electromagnetic radiation. Claim 4 eventually depends from Independent claim 1 and further recites that a greater

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volume of heated air is applied to a waistband as compared to a hip section. Claim 5 eventually depends from independent claim 1 and further recites that a higher temperature air flow is applied to a waistband as compared to a hip section. As discussed above with respect to claims 1 and 10, Elsberg and Jessup do not teach or suggest each and every element of the claimed invention. Moreover, applicants respectfully submit that neither Roland nor Thorson, alone or in combination correct for the deficiencies of Elsberg and Jessup. That is, Roland and Thorson in combination with Elsberg and Jessup fail to teach or suggest providing a "waistband-to-hip circumference ratio of about 95 percent or less at a 70 gram loading and a waistband-to-hip circumference ratio of about 100 percent at a 2000 gram loading." Accordingly, Applicants respectfully submit that claims 2, 4-5, and 11 are patentable over Elsberg in view of Jessup and further in view of Roland or Thorson.

Further, and with respect to claims 4 and 5, applicants reiterate that the Examiner has failed to point out how either Roland or Thorson teach or suggest providing a comparatively differentiated heat application to a waistband and a hip section of an article. That is, the Examiner has failed to indicate how Roland or Thorson disclose the step of applying a greater volume of heated air to a waistband as compared to a hip section, or the step of applying a higher temperature air flow to a waistband as compared to a hip section. Applicants recognize that the Examiner, on page 9 of the Office Action dated November 13, 2003, asserts that "the waist sections is (*sic*) what was exposed to the heat primarily and thus the hip sections are not exposed to excess and as much heating." Initially, Applicants point out that the Examiner has not indicated with particularity where support for this assertion may be found in Roland or Thorson. Nonetheless, Applicants submit that Figs. 7A – 7C of Roland and Figs. 5 – 7 of Thorson appear to indicate that heat or radiation would be applied to the portion of the garment that would be placed about the hips of the wearer as well as the portion of the waist area of the garment. Therefore, for at least these additional reasons, claims 4 and 5 are patentable over Elsberg in view of Jessup and further in view of Roland or Thorson.

The combination of Elsberg and Jessup further in view of Baird or Muckenfuhs fail to teach or suggest all of the claim limitations.

In the Office Action mailed November 13, 2003, the Examiner rejects claims 6 and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Elsberg in view of Jessup and further in view of U.S. Patent No. 4,908,247 Issued March 13, 1990 to Baird et al. (hereinafter

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"Baird") or U.S. Patent No. 5,092,862 issued March 3, 1992 to Muckenfuhs et al. (hereinafter "Muckenfuhs"). This rejection is respectfully **traversed** to the extent it applies to the presently presented claims.

Claims 6 and 13 eventually depend from independent claims 1 and 10, respectively. As discussed above with respect to claims 1 and 10, Elsberg and Jessup do not teach or suggest each and every element of the claimed invention. Moreover, applicants respectfully submit that neither Baird nor Muckenfuhs, alone or in combination correct for the deficiencies of Elsberg and Jessup. That is, Baird and Muckenfuhs, in combination with Elsberg and Jessup, fail to teach or suggest providing a "waistband-to-hip circumference ratio of about 95 percent or less at a 70 gram loading and a waistband-to-hip circumference ratio of about 100 percent at a 2000 gram loading." Accordingly, Applicants respectfully submit that claims 6 and 13 are patentable over Elsberg in view of Jessup and further in view of Baird or Muckenfuhs.

In conclusion, and in view of the above amendments and remarks, reexamination, reconsideration and withdrawal of the rejections of claims 1 – 6, 8 – 15, and 17 and 18 under 35 U.S.C. § 103 are respectfully requested. Moreover, it is respectfully submitted that all of the presently presented claims are in condition for allowance and such action is earnestly solicited. If the Examiner has any questions or if there are any remaining issues that can be handled by telephone, the Examiner is invited to contact the undersigned at (920) 721-3862.

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Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Barbara D. Miller, hereby certify that on February 9, 2003, this document is being sent by facsimile transmission addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA to facsimile number (703) 872-9306.

By: 

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